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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,627	06/15/2001	John G. Ciesar	5557-8	8478

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EXAMINER

ARYANPOUR, MITRA

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 10/01/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/882,627

Applicant(s)

CIESAR ET AL.

Examiner

Mitra Aryanpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Protests

1. A protest against issuance of a patent based upon this application has been filed under 37 CFR 1.291(a) on May 15, 2002, and a copy has been served on applicant. Any comments or reply applicant desires to file before consideration of the protest must be filed in response to this office action.

Consideration Of Protestor's Argument

1(a). The comments and points made on behalf of the Protestor are considered to have been addressed by the Examiner in the **§ 102 and § 103** rejections set forth below with respect to Kallassy.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 46 on page 11. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

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In claim 5, line 2, there is insufficient support in the specification and drawings for the bat to have a handle of differing weight. What is present in the specification is that the size of the handle 14 can be changed to accommodate various size players (see page 11, line 15 and 16; and page 12, line 20-22).

In claim 10, line 1, the limitation “the stopping means is constructed of plastic” has no support in the specification. See page 6, lines 11 and 12 and page 9, lines 9 and 10, which states that the stopping means is to be made of aluminum or any other suitable material. By indicating “any other suitable material” can be used, does not mean that a specific known material in the art can be claimed.

In claim 12, line 1 and 2, there is insufficient support in the specification to attach the stopping means to the shaft using epoxy glue (see page 6, lines 12 and 13).

In claim 14, the limitation “the head is adapted to have varying weights” appears on line 1. However, claim 14, is dependent on claim 13, which further recites that the “head is permanently affixed to the shaft”, meaning that the head cannot be removed in order to have heads with different weight attached to the end of the shaft. Therefore, there is insufficient support for this limitation.

In claim 15, there is sufficient support in the specification for the recitation of 12, 16, 20, 26 and 32 ounces.

In claim 24, there is insufficient support in the specification for a handle to be made of aluminum. The specification only supports the limitation “the grip handle resembles that of a conventional baseball bat handle” (see page 6, lines 4-6). By indicating “resembles that of a

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conventional baseball bat handle”, does not mean that any specific known material in the art can be claimed for the grip handle.

In claim 25, there is insufficient support in the specification for the shaft and/or handle to be made of metal alloy (see page 6, lines 4-6). By indicating the handle “resembles that of a conventional baseball bat handle” and the “shaft is made of aluminum”, does not mean that any specific known material in the art can be claimed for the shaft and/or grip handle.

Appropriate correction is required for the above objections.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 5, line 2, there is insufficient support in the specification and drawings for the bat to have a handle of differing weight. What is present in the specification is that the size of the handle 14 can be changed to accommodate various size players (see page 11, line 15 and 16; and page 12, line 20-22).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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7. Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, again claim 13 recites the limitation that “the head is permanently affixed to the shaft”, but claim 15, recites “the head is adapted to receive interchangeable weight members” on lines 1 and 2. There is insufficient support in the specification for this limitation. The head is not adapted to receive interchangeable weights. What is present in the specification is that the interchangeable heads 16 and the cap 40 may be made with varying weights (see page 11, lines 17-19). That means that heads of various weights are interchangeably connected to the shaft, but it does not imply that the weights are receivable within the head.

In claim 16, again claim 13 recites the limitation “the head is permanently affixed to the shaft”, but claim 16 further recites “the head is removably attached to the shaft . . .”. The limitation is in contradiction with the limitation of claim 13.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 6 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Mollica (5,360,209).

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Mollica discloses a batting swing trainer (10) comprising: a shaft (22) having a substantially uniform circumference and first and second ends; a handle (12) attached to the first end; the second end having an area of increased circumference (28) relative to the remainder of the shaft (22); a slide (20) mounted on the shaft (20) and movable between the first and second shaft ends; means (the upper portion of 12, where 24 is housed) positioned on the shaft adjacent to the handle (12) for stopping movement of the slide in the direction of the handle (12).

Regarding claim 6, Mollica's device meets the structural limitation of the claimed invention, therefore it is capable of being used such that a person may place one hand on the handle (12) and the other hand on the slide (20) to simulate a batting stance; and the person may simulate batting by swinging the trainer while simultaneously moving the slide along the shaft (22) from a first position adjacent the head to a second position adjacent the handle.

Regarding claim 13, Mollica shows the area of increased circumference on the second end of the shaft is a head (28) permanently affixed to the shaft(22).

IN ADDITION:

10. Claims 1, 6, 8, 9, 11, 13, 14, 16, 17, 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Kallassy (WO 99/26705).

Kallassy discloses a swing trainer device that can be used for golf and/or baseball (see page 14, lines 14-19) comprising (10): a shaft (12) having a substantially uniform circumference and first and second ends; a handle (14) attached to the first end; the second end having an area of increased circumference (16) relative to the remainder of the shaft (12); a slide (20) mounted on the shaft (12) and movable between the first and second shaft ends (see figure 1); means (22)

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positioned on the shaft (12) adjacent to the handle (14) for stopping (see page 9, lines 1-19) movement of the slide (20) in the direction of the handle (14).

Regarding claim 6, Kallassy further teaches that a person may place one hand on the handle and the other hand on the slide to simulate a golfing or batting stance; and the person may simulate golfing or batting by swinging the trainer while simultaneously moving the slide along the shaft from a first position adjacent the head to a second position adjacent the handle (see page 9, lines 19-28; and page 10, lines 6).

Regarding claim 8, Kallassy shows the fasteners contain cooperating threaded members (see page 12, lines 24-26).

Regarding claim 9, Kallassy shows the stopping means (202) comprises a ring (the stop means is ring-shaped; see page 12, line 10 and 11) secured to the shaft (12).

Regarding claim 11, Kallassy shows the stopping means (202) is secured to the shaft by a pin (see page 12, lines 21-25).

Regarding claim 13, Kallassy shows the area of increased circumference (16) on the second end of the shaft is a head permanently affixed to the shaft (see page 8, lines 1 and 2).

Regarding claim 14, Kallassy further shows the head (16) is adapted to have weights (see page 13, lines 18-28; and page 14, lines 1-8).

Regarding claim 16, Kallassy in an alternative embodiment shows the head (330) is removably attached to the shaft (12; see page 13, lines 18-28). Kallassy does not expressly disclose that the head can be interchanged with heads of differing weights. However, it is well known in the practice and training art to alter the amount of weight in order to accommodate various size players.

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Regarding claim 17, Kallassy further shows the head (330) is secured to the shaft by a pin (332; see page 14, lines 1-4).

Regarding claims 19 and 20, Kallassy shows the slide (20) has means on one end (24) for contacting the stopping means (22), and protecting the user's hands from being pinched (see page 9, lines 1-7); and means on the other end for contacting the head and protecting the user's hands from being pinched (see page 9, lines 13-18).

Regarding claim 21, Kallassy further shows the contacting and protecting means are rings (see figure 5, wherein the upper and lower sections of the slide form ring-like formations) affixed to the distal ends of the slide (20)

Regarding claim 22, Kallassy shows the handle (14) and slide (20) have substantially the same diameter (see figures 2 and 4).

Regarding claim 23, Kallassy shows the handle (14) and the slide (20) have substantially the same external covering (see page 8, lines 9-11; and page 11, lines 20 and 21).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kallassy (WO 99/26705) in view of Tetreault (4,671,508).

Regarding claims 2 and 3, Kallassy shows the handle (12) and slide (20) are each provided with any suitable material or combination of materials, preferably using hard rubber or durable plastic. Kallassy does not expressly show the use of foam or leather to cover the handle portion. Tetreault shows a practice bat, wherein the handle portion (14) is wrapped with a flexible deformable tape such as leather, rubber or plastic (15). It would have been obvious in view of Tetreault to have used any of the above known material for the handle portion of Kallassy, since they are considered art recognized equivalents.

13. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kallassy (WO 99/26705) in view of Bratt (3,955,816).

Regarding claim 5, Kallassy teaches alternative handles (see page 12, lines 1-7). However, Kallassy does not expressly disclose that the handles are removable. To provide handles that are integral or releasably removed with respect to the shaft is well known in the sports art and demonstrated by Bratt. Bratt shows a warm-up bat wherein the bat has a series of different sized interchangeable handles which fasten and unfasten from the tubular section to permit access to the hollow chamber and to allow change to the effective size of the bat (see claim 4). It would have been obvious in view of Bratt to have provided the same for Kallassy's bat and/or club.

14. Claims 7, 10, 12, 18, 24, 25, 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kallassy (WO 99/26705).

Regarding claim 7, Kallassy shows the stopping means (22, or in the alternative 202) adapted to fit around the shaft (see figures 4 and 12), such first and second portions being secured to the shaft with fasteners (see page 12, lines 8-26). Kallassy does not show a two-piece stopping means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the stopping means of Kallassy in two parts, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art, and it would allow the stopping means to be put around the shaft more efficiently. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Regarding claim 10, Kallassy does not expressly disclose the material used to make the stopping means. Plastic is a well-known material in the art. Official Notice is taken of such.

Regarding claim 12, Kallassy does not suggest the use of epoxy glue to secure the stopping means to the shaft, but suggests other means of attachment (see page 6, lines 12 and 13). The use of epoxy glue is well known in the securement art. Official Notice is taken of such.

Regarding claim 18, Kallassy in a first embodiment shows the head (16) to be secured to the shaft (12). To make the head an integral part of the shaft is well known, it is also well known to make the head and shaft of two parts that are connected together in a variety well known ways including the use of epoxy glue. Official Notice is taken of such.

Regarding claims 24 and 25, Kallassy does not expressly disclose the use of aluminum or metal alloy for the shaft and handle. However, the aforementioned materials are well recognized in the art, and it would have been obvious to use either one for the practice device of Kallassy. Official Notice is taken of such.

Regarding claims 26-32, Kallassy as disclosed above shows an apparatus and method of using a training device. The apparatus of Kallassy meets the structural limitations of the claimed invention. Kallassy teaches a person the proper technique for swinging a golf club, and extends the teaching method to include other sports, specifically Baseball. The steps being gripping the handle with one hand and gripping the slide with the other hand; and swinging the trainer while simultaneously moving the slide from the first position where it is adjacent to the second end to the second position where the slide is adjacent the stop; the person grips the handle adjacent to the stop; the person swings the club/bat head outwardly and away from the person's body; the person repeating the steps of swinging the trainer; holding the trainer with both hands similar to holding a conventional golf club/baseball bat, and swinging the club/bat in the same manner as a conventional club/bat, causing the slide to move along the shaft until it strikes the area of increased circumference of the second end of the shaft and emits an audible sound, whereby the person can determine the force of the swing. Kallassy may not recite the exact teaching, but one skilled in the art would have modified the method steps to accommodate a batting swing.

15. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mollica (5,360,209) in view of Bratt (3,955,816).

Mollica as disclosed above shows the shaft (22) to be hollow (26), but does not show the weight to be inserted within the hollow shaft, rather the weight is slidably positioned over the shaft. Brat shows a warm-up bat having a handle and a hollow chamber (12), wherein weight (18) can be received within the hollow chamber, and the amount of weight can readily be adjusted by removing the plug (20). It would have been obvious in view of Brat to have also

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included weight within the hollow shaft of Mollica in order to be able to adjust the weight of the training bat of Mollica in order to accommodate various size players with various training needs.

16. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kallassy (WO 99/26705) as applied to claim 13, and further in view of Bratt (3,955,816).

Kallassy as disclosed above does not indicate the amount of weight that is being used for training a player. Bratt as disclosed above also does not indicate the amount of weight that is added or subtracted to the hollow chamber, but teaches that the weight can be varied in order to achieve different size and weight combinations. It would have been obvious in view of Bratt to one having ordinary skill in the art at the time the invention was made to have adjusted the weight means of Kallassy in order to accommodate various size players with various training needs. It is further noted that applicant does not appear to assign any criticality for the claimed weight range.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chartier; Owen et al; Ylitalo; Blake; Rewolinski; Hamilton et al; Muhlhausen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703 308 3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703 308 2126. The fax phone numbers for the

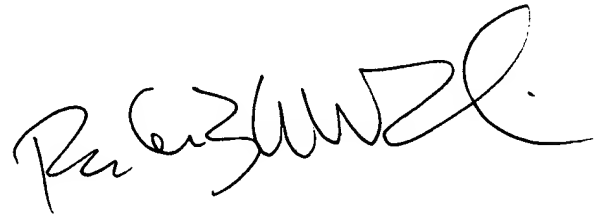
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organization where this application or proceeding is assigned are 703 308 7768 for regular communications and 703 305 3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1148.



RALEIGH W. CHIU
PRIMARY EXAMINER

MA
September 30, 2002